

ESTTA Tracking number: **ESTTA271548**

Filing date: **03/11/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Linden Research, Inc.
Granted to Date of previous extension	03/11/2009
Address	945 Battery Street San Francisco, CA 94111 UNITED STATES
Attorney information	James R. Cady and Bobby A. Ghajar Howrey LLP 1950 University Avenue, 4th Floor East Palo Alto, CA 94303 UNITED STATES CadyJ@howrey.com, GhajarB@howrey.com, RenojoR@howrey.com, IPDocketing@howrey.com Phone: (650) 798-3617

Applicant Information

Application No	79047766	Publication date	11/11/2008
Opposition Filing Date	03/11/2009	Opposition Period Ends	03/11/2009
International Registration No.	0947588	International Registration Date	11/26/2007
Applicant	Bastian BRÄ#BACH Im Forst 1 56191 Weikersburg GERMANY		

Goods/Services Affected by Opposition

<p>Class 009.</p> <p>All goods and services in the class are opposed, namely: Computer game software; magnetic recording media, namely, pre-recorded video cassettes and audio cassettes featuring video games, movies and music for entertainment purposes; pre-recorded sound and image magnetic data carriers featuring video games, music and movies; phonograph records, audio tapes, compact discs (CDs) and digital video discs (DVDs) featuring video games, movies and music; blank magnetic data carriers; pre-recorded magnetic data carriers featuring video games, movies and music for entertainment purposes</p>
<p>Class 016.</p> <p>All goods and services in the class are opposed, namely: Printed matters, namely, pamphlets, brochures, newsletters, journals, magazines concerning video games, movies and music; prints, blank writing journals, journals concerning video games, movies and music, newspapers, books concerning video games, movies and music, comic books; bookbinding materials; posters; stickers as stationery; calendars; picture postcards; photographs; stationery; writing paper, visiting cards; transfer pictures; penholders, ball pens, pencils and crayons, writing cases, blotting pads; paper as</p>

packaging materials; carrying bags made of paper; flags made of paper, small flags made of paper; printed paper signs, advertising boards made of paper or cardboard

Class 041.


All goods and services in the class are opposed, namely: Electronic publishing services, namely, publication of text and graphic works of others on CD, DVD and online featuring video games, movies and music for entertainment purposes; multimedia publication of books, magazines, journals, software, games, music, and electronic publication; publication of printed matters, brochures, posters, pamphlets, books, magazines, newspapers and journals, comics, except for advertising purposes; publication of newspapers, magazines and books in electronical form, also on the internet; entertainment in the nature of visual and audio performances, and musical, variety, news and comedy shows; organizing community sporting and cultural events

Grounds for Opposition

Priority and likelihood of confusion

Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77198345	Application Date	06/05/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SL		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: Software that is used for providing multi-user access to an on-line 3D virtual environment; computer software used to create, manipulate and participate in 3D virtual environments</p> <p>Class 038. First use: Communication services in the nature of text messaging and electronic mail services used in an online virtual environment</p> <p>Class 042. First use: Computer services, namely, hosting an on-line 3D virtual environment featuring a wide variety of user-defined subject matter, and hosting an on-line 3D virtual environment featuring a wide variety of user-defined subject matter that may be accessed by means of communications networks; design and development of multimedia and three dimensional virtual environment software</p>		

Attachments

77198345#TMSN.jpeg (1 page)(bytes)
SLM Opposition - Notice of Opposition & Exhibits.pdf (13 pages)(4253274 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JRCady/
Name	James R. Cady and Bobby A. Ghajar
Date	03/11/2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:	§	
Bastian Brübach	§	
	§	International Classes: 9, 16 and 41
Serial No.: 79/047766	§	
	§	Published: November 11, 2008
Filed: November 26, 2007	§	
	§	
Mark: SLM	§	

Box TTAB FEE
Commissioner for Trademarks
P. O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Madam:

Linden Research, Inc. a Delaware corporation, having its principal place of business at 945 Battery Street, San Francisco, California 94111 ("Opposer") hereby opposes Application Serial No. 79/047766 filed by Bastian Brübach ("Applicant") under the provisions of 15 U.S.C. §1063 (as amended). The Commissioner for Trademarks is hereby authorized to draw on the deposit account No. 08-3038, Order No.04758.0044.000000/Cady for any necessary fees.

Application Serial No. 79/047766 was filed on November 26, 2007 for the mark SLM for "computer game software; magnetic recording media, namely, pre-recorded video cassettes and audio cassettes featuring video games, movies and music for entertainment purposes; pre-recorded sound and image magnetic data carriers featuring video games, music and movies; phonograph records, audio tapes, compact discs (CDs) and digital video discs (DVDs) featuring video games , movies and music; blank magnetic data carries; pre-recorded magnetic data carriers featuring video games, movies and music for entertainment purposes" in International

Class 9, “printed matters, namely, pamphlets, brochures, newsletters, journals, magazines concerning video games, movies and music; prints, blank writing journals, journals concerning video games, movies and music, newspapers, books concerning video games, movies and music, comic books; bookbinding materials; posters; stickers as stationery; calendars; picture postcards; photographs; stationery; writing paper, visiting cards; transfer pictures; penholders, ball pens, pencils and crayons, writing cases, blotting pads; paper as packaging materials; carrying bags made of paper; flags made of paper, small flags made of paper; printed paper signs, advertising boards made of paper or cardboard” in International Class 16, and “electronic publishing services, namely, publication of text and graphic works of others on CD, DVD and online featuring video games, movies and music for entertainment purposes; multimedia publication of books, magazines, journals, software, games, music, and electronic publication; publication of printed matters, brochures, posters, pamphlets, books, magazines, newspapers and journals, comics, except for advertising purposes; publication of newspapers, magazines and books in electronical form, also on the internet; entertainment in the nature of visual and audio performances, and musical, variety, news and comedy shows; organizing community sporting and cultural events” in International Class 41. The application was published for opposition on November 11, 2008.

An extension of time has been obtained up until March 11, 2009. Therefore, this Opposition is timely.

As grounds for the opposition, it is alleged that:

1. Opposer created and operates SECOND LIFE[®], the world's leading 3D online virtual world, in which users (called "residents") interact, explore, and create content and experiences for social, business, and educational purposes – much like how users create websites on the internet, but in a virtual 3D environment.

2. SECOND LIFE[®] has over 14 million subscribers in the United States and around the world. It is featured regularly in news commentary and popular culture, and has been licensed for use in several prime time television shows. Many educational institutions, including Harvard, Princeton, and Stanford Universities, have virtual campuses in SECOND LIFE[®] where they host classes, events, and information resources. As a result, the SECOND LIFE[®] virtual world has rapidly become well-known among the general population.

3. Opposer has adopted and uses the mark SL[™] as an abbreviation for its SECOND LIFE[®] virtual world. The SL mark is used by Opposer and its licensees in connection with products and services in and for the SECOND LIFE[®] virtual world environment. Attached as Exhibit A are screen shots of Opposer's websites for Second Life and Second Life Wiki showing use of SL as a trademark for its goods and services.

4. In addition to its valid common law rights in the SL mark, Opposer is the owner of United States Trademark Application Serial No. 77/198345 to register the SL mark (filed June 5, 2007) for "software that is used for providing multi-user access to an on-line 3D virtual environment; computer software used to create, manipulate and participate in 3D virtual environments" in International Class 9, "communication services in the nature of text messaging and electronic mail services used in an online virtual environment" in International Class 38 and "computer services, namely, hosting an on-line 3D virtual environment featuring a wide variety

of user-defined subject matter, and hosting an on-line 3D virtual environment featuring a wide variety of user-defined subject matter that may be accessed by means of communications networks; design and development of multimedia and three dimensional virtual environment software” in International Class 42. A true and correct copy of this application is appended to this Notice of Opposition as Exhibit B.

5. The term SL is inherently and highly distinctive inasmuch as it is a coined term that in no way describes any ingredient, quality, characteristic, function, feature, purpose or use of the goods and services to which it is applied.

6. As a result of Opposer’s substantial online use and marketing efforts, the common law mark SL has established strong recognition and substantial goodwill among technology users and consumers.

7. Opposer’s first use of and application to register the SL mark predate the filing date for Applicant’s SLM trademark application and Applicant’s alleged first use of the SLM mark in commerce.

8. Upon information and belief, Applicant is a subscriber or “resident” of SECOND LIFE[®], or SL[™], and is therefore familiar with Opposer and its use of SL. Applicant has adopted and used the term SLM, which is a mere combination of Opposer’s SL mark appended with the letter “M,” as a reference to Applicant’s “Second Life Magazin,” a German-language magazine about Opposer’s SECOND LIFE[®] virtual world environment, and is currently using SLM to refer to “Second Life Music” for Applicant’s online music broadcasts provided in, for or relating to Opposer’s SECOND LIFE[®] virtual world environment.

9. Applicant’s SLM mark is extremely similar in appearance, sound and meaning to Opposer’s SL mark. The terms SLM and SL differ by only one letter. In addition, as stated

above, Applicant has used or is using SLM as an abbreviation for “Second Life Magazin” and “Second Life Music,” which are direct references to Opposer’s virtual world environment known as SECOND LIFE[®] or SL[™].

10. Applicant seeks registration of the mark SLM for a variety of computer-related goods and services that overlap with and are highly related to Opposer’s goods and services. Opposer’s virtual world environment provides the subject matter and the medium for Applicant’s goods and services.

11. Given the similarity between the marks; the relatedness of the parties’ products and services; Applicant’s use of Opposer’s virtual world to promote its goods and services; the overlap in consumers and target audience; and the strength of Opposer’s SL mark, Applicant’s SLM mark should not be registered because its use as a source identifier is likely to cause confusion with Opposer’s SL mark as to the source, sponsorship, or affiliation of Applicant’s goods and services. Consumers are likely to believe that Applicant’s SLM products or services (*e.g.*, its “Second Life Magazin” or SLM radio) are a licensed or permitted use, when in fact, they are not.

12. Contrary to the suggestion created by the use of the SLM mark, Opposer is neither affiliated with nor a sponsor of Applicant, and the goods and services identified in the opposed application do not originate from Opposer. Thus, Applicant’s SLM falsely designates the origin of Applicant’s goods and services.

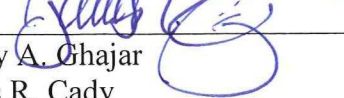
13. The registration of Applicant’s SLM mark on the Principal Register would be inconsistent with Opposer’s rights under the aforementioned pending trademark application and common law, and it would be damaging to Opposer.

WHEREFORE, Opposer requests that Application Serial No. 79/047766 be rejected, and that no registration be issued in connection with this application, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

LINDEN RESEARCH, INC.

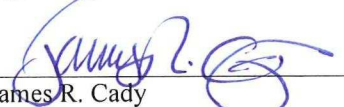
Date: March 11, 2009

By: 
Bobby A. Ghajar
James R. Cady
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1950 University Avenue, 4th Floor
East Palo Alto, CA 94303
(650) 798-3500
Attorneys for Opposer

CERTIFICATE OF ELECTRONIC TRANSMISSION

DATE OF DEPOSIT: March 11, 2009

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.


James R. Cady

CERTIFICATE OF SERVICE VIA MAIL

I, Rosario F. Renojo, secretary to James R. Cady, of Howrey LLP, attorneys for Opposer Linden Research, Inc., hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION was served on Applicant, Bastian Brübach, at his correspondence address of record, c/o Dr. Karl F. Grommes, Mehlgasse 14-16, 56068 Koblenz, Germany, via postage prepaid by first-class airmail on March 11, 2009.

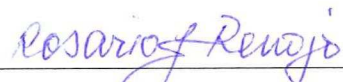

ROSARIO F. RENOJO

EXHIBIT A

EXHIBIT B



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SL

Word Mark SL
Goods and Services IC 009. US 021 023 026 036 038. G & S: Software that is used for providing multi-user access to an on-line 3D virtual environment; computer software used to create, manipulate and participate in 3D virtual environments

IC 038. US 100 101 104. G & S: Communication services in the nature of text messaging and electronic mail services used in an online virtual environment

IC 042. US 100 101. G & S: Computer services, namely, hosting an on-line 3D virtual environment featuring a wide variety of user-defined subject matter, and hosting an on-line 3D virtual environment featuring a wide variety of user-defined subject matter that may be accessed by means of communications networks; design and development of multimedia and three dimensional virtual environment software

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 77198345

Filing Date June 5, 2007

Current Filing Basis 1B

Original Filing Basis 1B

Published for Opposition September 16, 2008
International Registration Number 0971674
Owner (APPLICANT) Linden Research, Inc. CORPORATION DELAWARE 945 Battery Street San Francisco CALIFORNIA 94111
Attorney of Record Bobby A. Ghajar and James R. Cady
Type of Mark TRADEMARK. SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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